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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Advertising Marketing Services, Inc.

Serial No. 76554285

Eric J. von Vorys of Shulman Rogers Gandal Pordy & Ecker,
P.A. for Advertising Marketing Services, Inc.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Grendel, Rogers, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 27, 2003, Advertising Marketing Services,
Inc. (applicant) applied to register the mark shown below
on the Principal Register for "newspapers primarily
featuring classified advertisements and news articles" in
Class 16. Serial No. 76554285. The application is based
on applicant's assertion of a date of first use anywhere

and in commerce of September 1982. The application contains a disclaimer of the term "Newspapers."



The examining attorney refused to register the mark on the ground that the term "Merchandiser," when used in association with the goods, is merely descriptive. 15 U.S.C. § 1052(e)(1). Therefore, the examining attorney required a disclaimer of that term under the provision of Section 6 of the Trademark Act. 15 U.S.C. § 1056. After the examining attorney made the refusal final, applicant appealed to this board.

The examining attorney has submitted a definition of the verb "merchandise" as "to promote the sale of, as by advertising or display." Final Office Action at 2. Applicant also submitted numerous other definitions including one that defines a "merchandiser" as "a person engaged in buying and selling, businessperson, dealer, merchant, speculator, trader, tradesman, trafficker." See yourdictionary.com. Other definitions are similar. See, e.g., www.onelook.com dictionary [A trader], WordNet 2.0 Dictionary Helper [Merchant (a businessperson engaged in

retail trade), and www.RhymeZone.com (a businessperson engaged in retail trade)].

Applicant and the examining attorney disagree as to how the prospective customers will perceive the term. The examining attorney argues (Brief at 5, parenthetical omitted) that:

Applicant's dictionary definition of the term MERCHANDISER obviously describes a function, feature, purpose or use of applicant's goods. Applicant's newspaper is a marketing newspaper containing ads and articles from MERCHANDISERS advertising their goods or services. The entire *subject* of the newspaper is the MERCHANDISERS who advertise in the paper. The paper contains advertisements from MERCHANDISERS and *features* news and information about MERCHANDISERS. Therefore, the term MERCHANDISER is highly descriptive of an ingredient, quality, feature or characteristic and the subject of applicant's goods. No multi-step reasoning process would be required for a consumer to ascertain that Applicant's MERCHANDISER NEWSPAPERS are NEWSPAPERS containing ads from MERCHANDISERS.

Applicant sees the definitions in a different light (Brief at 5-6).

MERCHANDISER has the defined meaning of "a person engaged in buying or selling." When used in the title of a newspaper that contains classified advertisements and news articles MERCHANDISER is an example of personification; or the attribution of personal qualities to an inanimate object. A prospective purchaser upon seeing the term in connection with a newspaper containing an amalgamation of classified advertisements and news stories would have to use imagination and a multi-step thought process to discern what MERCHANDISER means. Consequently, the term is suggestive and not descriptive.

The front page from one of applicant's newspapers is set out below:



The front page contains advertisements from a mortgage company, a retail/wholesale seafood supplier, a plumber, and a flooring company. In addition, there are pictures that refer readers to advertisements on other pages for a

kitchen remodeler, a child care center, and a window installer.

The examining attorney also submitted seven registrations that are either registered under Section 2(f), on the Supplemental Register, or with a disclaimer of the term "Merchandiser." These registrations were submitted to show that the term merchandiser has been considered descriptive even when it did not directly refer to a person. See Registration Nos. 1,930,936 (ARMY/NAVY STORE & OUTDOOR MERCHANDISER for magazines, Section 2(f)); 2,208,319 (AUTOMATIC MERCHANDISER for magazines, Section 2(f)); 2,289,889 (PEEK-A-BOO MERCHANDISER for display racks, "Merchandiser" disclaimed); 2,447,195 (DIGITAL MERCHANDISER for digital signage, Supplemental Register); 2,481,042 (RETAIL MERCHANDISER for magazines, Supplemental Register); 2,511,430 (MED PLUS MERCHANDISER for product merchandising services, "Merchandiser" disclaimed); and 2,613,775 (MOBILE MERCHANDISER for display racks, 2(f)). The examining attorney also included evidence that the term "designer," which the examining attorney asserts is a similar term, was treated as a merely descriptive term in numerous registrations.

Applicant, in addition to the dictionary definitions, submitted other evidence. Some of this evidence includes

announcements for the position of merchandiser. See, e.g., www.volunteersolutions.org ("The merchandiser would help go through those donations, sorting those appropriate for work from clothing that is not"); and www.jobsearch.monster.ie (ATA Retail Services - Part Time Merchandiser... seeking ... Merchandisers to call on supermarkets in the Orange County area of Southern California").

Applicant also submitted two registrations that include the term "Merchandiser" and that were registered on the Principal Register. See Registration Nos. 2,432,961 (VISUAL MERCHANDISER for computer software for tracking inventory and retail sales database management) and 2,831,109 (LIVE!MERCHANDISER for computer software that allows messages to be broadcast within a website to interest users to visit a different location within the website).¹ Applicant also submitted more than a hundred declarations. The declarations, in addition to the declarant's name, provide the declarant's position and length of time the declarant's company has advertised in

¹ The examining attorney pointed out that while applicant had earlier submitted seven other registrations to support its argument that its term was not merely descriptive, six of those registrations were cancelled and the seventh was registered under the provision of Section 2(f), an acknowledgment of the term's descriptiveness. See Final Office Action at 2.

applicant's newspaper or, if not an advertiser, the length of time that they received the newspaper. The declarations conclude with the following two statements:

- I personally am familiar with the term MERCHANDISER and it is defined as a "businessperson engaged in retail trade."
- I am not aware of any definition of the term MERCHANDISER that means "a newspaper primarily featuring classified advertisements and news articles."

Case law establishes that a mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). To be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is merely descriptive. Abcor, 200 USPQ at 218.

We begin our analysis by noting that we agree with applicant that one of the definitions of the term "merchandiser" is "a businessperson engaged in retail trade." Applicant also has submitted evidence from which we can conclude that there is nothing unusual about the term. It is used in job vacancy advertisements and in job descriptions and applicant has submitted more than one hundred declarations from advertisers and readers who state that they are familiar with this term and its meaning.

We also note that applicant has included a definition of "merchandiser" from the www.TheFreeDictionary.com that similarly defines the term as "a businessperson engaged in retail trade." It then lists under the definition of "merchandiser" some of the following professions: merchant, book seller, bookdealer, butcher, clothier, haberdasher, grain merchant, grocer, jeweler, rug merchant, and wine merchant. See also www.wordreference.com. Applicant's specimens contain ads from plumbers, seafood merchants, mortgage lenders, home remodelers, roofers, landscapers, and heating and air conditioning specialists. Similarly, applicant's advertisers describe themselves as being in the window treatment, maid services, auto repair, carpet and

flooring, furniture, junk removal, floor refinishing, painting, duct cleaning, and kitchen remodeling industries. These merchants would all be considered as businesspeople engaged in retail trade. Applicant's magazine clearly contains advertisements from merchandisers.

If a newspaper featured advertisements from plumbers, the word "plumbers" would be descriptive. Applicant's term "merchandisers," which covers a broader class of businesspeople, is similarly descriptive. In re Hunter Publishing Co., 204 USPQ 957, 963 (TTAB 1979) ("There is no question from the contents of the publication of record herein that it is directed to jobber and warehouse managers or executives in the automotive aftermarket and that this would be the initial impact of the mark as used and encountered in the marketplace for such a publication. Accordingly, [the term JOBBER AND WAREHOUSE EXECUTIVE] is deemed to be merely descriptive of applicant's publication"); In re Home Builders Association of Greenville, 18 USPQ2d 1313, 1317 (TTAB 1990) ("[A]pplicant's real estate advertisement services involve the placing of advertisements in a buyer's guide of which the subject matter is new homes and associated products and services. The published guide itself is, in essence,

a guide comprised of advertisements for goods and services needed by buyers of new homes. We thus find that the mark [NEW HOME BUYER'S GUIDE], when used in connection with the services, immediately conveys the idea of advertising in a new home guide for buyers").

Both applicant and the examining attorney submitted copies of registrations to support their arguments concerning the registrability of the term "merchandiser." Third-party registrations can be used as a form of a dictionary definition to illustrate how the term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). While the evidence is somewhat mixed, the examining attorney has provided three registrations under Section 2(f) or on the Supplemental Register for the term "Merchandiser" used in association with publications. See Registration Nos. 1,930,936 (ARMY/NAVY STORE & OUTDOOR MERCHANDISER); 2,208,319 (AUTOMATIC MERCHANDISER); and 2,481,042 (RETAIL MERCHANDISER). Applicant's sole registration² (No. 2,432,961) is for computer software for tracking inventory and retail sales database management and it is less

² We note that the other registration that applicant relies upon (No. 2,831,109) is a compound mark and it is not clear from the registration how the term "Merchandiser" was treated. TMEP § 1213.05(a)(ii) (4th ed. April 2005).

relevant than the examining attorney's registrations for magazines. We, therefore, conclude that the examining attorney's registrations provide some support for the examining attorney's argument that the term "Merchandiser" is merely descriptive.

In this case, as applicant's declarants indicate, applicant's newspaper is marketed to merchandisers to advertise their various goods and services and it is delivered to readers who are prospective purchasers of the merchandisers' goods and services. The term "Merchandisers" describes applicant's advertisers, i.e., businesspeople engaged in retail trade. It also describes a feature of applicant's newspapers to the extent that it describes the subject matter of applicant's magazines inasmuch as applicant's newspapers consists primarily of advertisements of merchandisers. We cannot agree with applicant's argument that the term "Merchandiser" would be viewed as "an example of personification; or the attribution of personal qualities to an inanimate object." Brief at 5. Simply referring to a person rather than a subject in a title of a publication does not by itself mean that prospective purchasers would view the term as a personification and not a descriptive term. See Hunter Publishing, 204 USPQ at 963 (JOBBER AND WAREHOUSE

EXECUTIVE) and Home Builders Association, 18 USPQ2d at 1317 (NEW HOME BUYER'S GUIDE). Advertisers would understand that the term indicates that it is a publication for merchandisers to advertise their goods and services and readers would similarly understand it as a newspaper that contains advertisements from merchandisers. Therefore, we conclude that the term "Merchandiser" is merely descriptive of applicant's newspapers.

We also note that applicant's mark is not shown in standard character form.³ While the term "Merchandiser" is part of a stylized design, when "words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed, under Section 6." In re Clutter Control, Inc., 231 USPQ 588, 589 (TTAB 1986). Applicant has not disclaimed the term "Merchandiser" and sought protection for the design alone. See In re Wella Corp., 635 F.2d 845, 196 USPQ 7 (CCPA 1977) (BALSAM (stylized) for shampoo registrable on the Supplemental Register with a disclaimer of the word)

³ Despite its allegation of long use, applicant has not asserted that the term "Merchandiser" has acquired distinctiveness under the provision of Section 2(f) of the Trademark Act. Therefore, this issue is not before us.

and In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985) (LITE (stylized) for beer registrable of the Principal Register with a disclaimer of the word).

When we view applicant's mark as a whole, the term MERCHANDISER NEWSPAPERS in the mark merely describes that applicant's newspapers contain advertisements of local merchants or merchandisers. As a result the term MERCHANDISER is merely descriptive and the examining attorney's refusal to register the mark without a disclaimer of the term is affirmed.

Decision: The examining attorney's refusal to register applicant's mark without a disclaimer of the merely descriptive term "Merchandiser" is affirmed. If applicant submits an appropriate disclaimer of the word "Merchandiser" within thirty days of the mailing date of this decision, the refusal to register will be reversed.